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SEARCH NUMBER	FILED DATE	FIRST NAME & INVENTOR	ATTORNEY DOCKET NO.
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07/508, 109 04/11/90 BORMANN

J MERZ 16
EXAMINER

WILSON, T

ART UNIT

PAPER NUMBER

4

125

DATE MAILED:

01/15/91

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on 5/7/90, 4/11/90 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice re Patent Drawing, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, Form PTO-152
5. Information on How to Effect Drawing Changes, PTO-1474.
6. _____

Part II SUMMARY OF ACTION

1. Claims 1-13 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims 1-9, 11-13 are allowed.

4. Claims 10 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).

12. Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

EXAMINER'S ACTION

Art Unit 125

Claims 1-13 are presented for examination.

Various documents have been received and placed of record in the file: Priority Paper (05/07/90), and Prior Art/Disclosure (04/11/90).

35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title".

Claim 10 is rejected under 35 U.S.C. § 101 because the claimed invention lacks patentable utility. In particular, the claim that compounds of Formula I prevent Alzheimer's disease is seen as an incredible utility, since no studies to date have proven that such is possible.

Claim 10 is rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited to the limited enabling disclosure of pages 1-24 of the Specification. See M.P.E.P. §§ 706.03(n) and 706.03(z). Specifically, there is no support for the claim that compounds of Formula I prevent Alzheimer's disease.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability

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shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claim 10 is rejected under 35 U.S.C. § 103 as being unpatentable over European Application 0,227,410 (Reference L). Reference L discloses that adamantane derivatives may be used to treat Alzheimer's disease and Alzheimer dementia: see

page 6, line 19, wherein R4 of Formula I is adamantyl,
page 8, line 8, wherein Y1 of Formula II is adamantyl,
pages 31-33, for the synthesis of an adamantyl compound,
page 15, lines 4-5, wherein Alzheimer utility is disclosed,
Claims 12 and 13, directed to treating dementia.

Thus, it would have been obvious to one skilled in the art to employ an adamantane compound (based on Reference L) to treat Alzheimer's disease.

CLAIMS 1-9 AND 11-13 ARE ALLOWED.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Terry Wilson, whose telephone number is (703) 308-3728.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

t. wilson

T. Wilson

01/10/91

703-308-3728

Primary Examiner
Group Art Unit 1